Supreme Court, U.S.
FILED

05-378 SEP 16 2005

OFFICE OF THE CLERK

No. _____

In the Supreme Court of the United States

KENNETH HARRIS AND JACQUELINE B. WAHL,
Petitioners,

v.

JOHN DUDAS, Acting Director,
United States Patent and Trademark Office,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR WRITE OF CERTIORARI

JAMES A. MITCHELL
Counsel of Record

PRICE, HENEVELD, COOPER,
DEWITT & LITTON LLP
695 KENMOOR, S.E.
POST OFFICE BOX 2567
GRAND RAPIDS, MI 49501
(616) 949-9610

Counsel for Petitioner

Becker Gallagher Legal Publishing, Inc. 800.890.5001

QUESTIONS PRESENTED

In its desire to render patent law more predictable, the Federal Circuit Court of Appeals has again, as it did in *Festo,*[1] pronounced a hard and fast rule of law in certain types of patent cases, this one involving "*prima facie* obviousness." The Patent Office has traditionally held patent application claims to be "*prima facie* obvious" when a preponderance of the factual evidence compels a conclusion that the claims are unpatentable for obviousness. This then shifts the burden of proof to the applicant to overcome the "*prima facie* obvious" holding, typically by proving that the claimed invention yields surprising and unexpected results.

Now, the Federal Circuit has held that any time a disclosed prior art composition range encompasses or overlaps a patent application claimed range, the claimed range is *prima facie* obvious – ***regardless of facts*** bearing on the question of obviousness, such as (1) the vastness of the number of compounds encompassed by the prior art relative to the claims, (2) the purpose of the prior art disclosure, (3) the extent to which the prior art disclosure is enabling or merely speculative, and (4) contrary preferences expressed by the prior art. Further, the Federal Circuit held that since a compound within the claimed range is as representative of the prior art as one outside the claimed range, the applicant ***cannot overcome*** the finding of *prima facie* obviousness by proof of surprising and unexpected results. The Federal Circuit decision makes it substantially impossible to obtain

---

[1] In *Festo Corp. v. Shoketsu KKK Co.*, 234 F.3d 558 (Fed. Cir. 2000), reversed 535 U.S. (2002), the Federal Circuit held that any amendment to patent application claims precludes any range of equivalents for the amended limitation.

patents in a number of technologies, including high temperature nickel super alloys which are critical to national defense and the aviation industry.

The questions presented in this Petition are:

1. **Whether a determination of *prima facie* obviousness in encompassing or overlapping range cases should, as in all other *prima facie* obviousness cases, be based on an analysis of all factual evidence rather than being applied automatically, without regard to the facts?**

2. **Whether a patent applicant should be entitled to prove surprising and unexpected results based on a composition within its claimed range, even though the composition is also encompassed by a very board prior art range, and hence, according to the Federal Circuit, "is representative of the prior art?"**

Petitioner answers both questions in the affirmative.

RULE 29.6 CORPORATE DISCLOSURE STATEMENT

Petitioner Cannon-Muskegon Corporation is a wholly owned subsidiary of Precision Castparts, Corporation Portland, Oregon, a publicly held company. There are no publicly held companies that own 10% or more of the corporate stock of Precision Castparts, Corporation.

TABLE OF CONTENTS

Questions Presented i

Corporate Disclosure Statement iii

Table of Contents iv

Table of Authorities vii

Opinions and Orders Below 1

Jurisdiction 1

Constitutional Provisions, Statutes, and Federal Regulations 1

Statement of the Case 2

I. Introduction 2

II. The Harris and Wahl Invention 4

III. The Rejected Claims 5

IV. The Federal Circuit Decision 6

Reasons for Granting the Petition 7

I. *PRIMA FACIE* OBVIOUSNESS SHOULD BE DETERMINED BY A PREPONDERANCE OF THE EVIDENCE, NOT BY THE MECHANICAL APPLICATION OF A RULE OF LAW 7

II. THE FEDERAL CIRCUIT HAS PREVIOUSLY HELD THAT THE DISCLOSURE OF A HUGE GENUS DOES NOT RENDER OBVIOUS CLAIMS TO A NARROW SPECIES 10

III. THE YOSHINARI DISCLOSED RANGE OF POSSIBLE ALLOYS IS HUGE COMPARED TO THE CLAIMED RANGES OF HARRIS AND WAHL 12

IV. THE YOSHINARI DISCLOSURE IS SPECULATIVE AND SUBSTANTIALLY NON-ENABLING OVER THE HUGE RANGE OF SPECIES ENCOMPASSED BY THE DISCLOSED GENUS 13

V. YOSHINARI'S CLAIMED INVENTION IS A TURBINE VANE, NOT A NICKEL SUPER ALLOY 14

VI. YOSHINARI'S PREFERRED RANGES TEACH AWAY FROM THE CLAIMED INVENTION . . . 14

VII. THE CASES RELIED ON BY THE FEDERAL CIRCUIT ARE DISTINGUISHABLE OR SHOULD BE OVERRULED 16

VIII. CASE LAW SHOULD NOT MAKE IT IMPOSSIBLE TO DEMONSTRATE SURPRISING AND UNEXPECTED RESULTS IN OVERLAPPING RANGE CASES 19

IX. CONCLUSION 20

APPENDIX

Appendix A
Opinion of the Court of Appeals for the Federal Circuit, 409 F.3d 1339, 74 U.S.P.Q.2d 1951 (Fed. Cir. 2005) 1a

Appendix B
Order of the Court of Appeals denying Petition For Rehearing En Banc 12a

Appendix C
Decision On Appeal of the United States Patent and Trademark Office Board of Patent Appeals and Interferences 14a

Appendix D
Decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences denying Request For Rehearing 28a

Appendix E
Rejected nickel super alloy patent application claims of Harris and Wahl 33a

Appendix F
Two page bar graph comparing the breadth of the ranges for each minor alloy element disclosed in Yoshinari's broad disclosure and preferred disclosure to the narrow range for those elements in the Harris and Wahl patent application claims 37a

TABLE OF CITED AUTHORITIES

Cases

Festo Corp. v. Shoketsu KKK Co.,
234 F.3d 558 (Fed. Cir. 2000),
reversed 535 U.S. ___ (2002) i

Graham v. John Deere,
383 U.S. 1 (1966) 3, 8, 9, 12, 19

In re Baird, 16 F.3d 380 (Fed. Cir. 1994) . . . . . *passim*

In re Geisler,
116 F.3d 1465 (Fed. Cir. 1997) 7, 17, 20

In re Huang, 100 F.3d 135 (Fed. Cir. 1996) 7

In re Jones, 958 F.2d 347 (Fed. Cir. 1992) 9

In re Malagari, 499 F.2d 1297 (CCPA 1974) 7, 17

In re Peterson,
315 F. 3d 1325 (Fed. Cir. 2003) . . 6-7, 10, 11, 16, 17

In re Spada, 911 F.2d 705 (Fed. Cir. 1990) 8

In re Woodruff,
919 F.2d 1575 (Fed. Cir. 1990) 7, 17, 20

Constitutional and Statutory Provisions and Regulations

37 C.F.R. § 1.56 . . . . . 2, 8
U.S. Const. Art. I, Sec. 8 . . . . . 1, 7
28 U.S.C. § 1254(1) 1
28 U.S.C. § 1295(a)(4)(A) 2
35 U.S.C. § 103 . . . . . 8, 9
35 U.S.C. § 103(a) 2

OPINIONS AND ORDERS BELOW

The Opinion of the Court of Appeals for the Federal Circuit (App. A, *Infra*, 1a-11a) is reported at 409 F.3d 1339, 74 U.S.P.Q.2d 1951 (Fed. Cir. 2005). The Order of the Court of Appeals denying a Petition For Rehearing En Banc (App. B, *Infra*, 12a-13a) is unreported. The Decision On Appeal of the United States Patent and Trademark Office Board of Patent Appeals and Interferences (App., C *Infra*, 14a-27a) is unreported. The Decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences denying a Request For Rehearing (App. D, *Infra*, 28a-32a) is unreported.

JURISDICTION

The judgment of the Court of Appeals for the Federal Circuit was entered on May 25, 2005. A Petition For Rehearing En Banc was denied on June 30, 2005. 28 U.S.C. §1254(1) confers on the Court jurisdiction to review on a writ of certiorari the judgment in question.

CONSTITUTIONAL PROVISIONS, STATUTES AND FEDERAL REGULATIONS

Article I, Section 8 of the Constitution of the United States provides in pertinent part:

> The Congress shall have power . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries; . . ..

Section 103(a) of the Patent Laws of the United States, Title 35, provides:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this Title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

United States Patent Office Rule 37 CFR Section 1.56 provides in pertinent part:

> "A *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden of proof standards."

STATEMENT OF THE CASE

I. INTRODUCTION

The United States Patent Office Examiner, having rejected the patent application of Kenneth Harris and Jacqueline B. Wahl on a high temperature nickel super alloy, (a) the statutory basis for jurisdiction of the Board of Patent Appeals and Interferences was 35 USC §134; (b) upon affirmation by the Board of Patent Appeals and Interferences, the statutory basis for jurisdiction of the Court of Appeals for the Federal Circuit was 28 USC §1295(a)(4)(A).

High temperature nickel super alloys are vital to our national defense and our national economy. They comprise an alloy of nickel and 10-15 other elements in various minor proportions, used primarily in casting jet engine turbine vanes which must withstand temperatures of 2,000° F. It is recognized in this art that minor changes in the amounts of these minor constituents can make a significant difference in the properties of the resulting alloys. Ongoing research and development in nickel super alloy technology is of critical importance to the United States.

It is no exaggeration to say that the Federal Circuit decision from which relief is sought renders unpatentable most future nickel super alloys which may be developed, in that:

1. Contrary to the fact based obviousness inquiry required by the United States Supreme Court in *Graham v. John Deere*, the Federal Circuit has established a rule of law that any time a prior art reference discloses a range which encompasses or overlaps a claimed range, the claims are *prima facie* obvious;

2. In the case of nickel super alloys, almost any conceivable species of nickel super alloy falls within the huge substantially non-enabled, speculative genus disclosed in the prior art Yoshinari reference relied on by the Patent Office and the Federal Circuit; and

3. The Federal Circuit decision makes it impossible to overcome *prima facie* obviousness with evidence of "surprising and unexpected results," by holding that any composition within a claimed